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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,751	09/28/2001	Jean Mondet	05725.0960-00	3105

22852 7590 06/16/2005

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EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,751

Applicant(s)

MONDET ET AL

Examiner

Edward J. Webman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) 9, 14-20, 22-38, 46-48, 51, 56, 62, 64, 66 and 73-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 21, 39-45, 49-50, 52-55, 57-61, 63, 65, 67-72, 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

5.0.0

Applicants noted the discrepancy between the claims indicated as rejected and objected to on PTO form 326 of the action filed 9/17/04 and the claims indicated as rejected under 35 USC 103 on page 2 of the action. Applicants also note that claim 5 is an independent claim, therefore, it and claims dependent from it should have been indicated as allowed rather than objected to. After further consideration of the claims, claims 5-8 should have been indicated as rejected and claims 9, 46-48 should have been indicated as directed to non-elected species. Therefore, the following rejection is made non-final to remedy the inconsistencies noted by applicants and to give applicants an opportunity to respond to the newly rejected claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-13, 21, 39-45, 49-50, 52-55, 57-61, 63, 65, 67-72, 77 rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al in view of Kantner et al.

Arnaud et al claim a lipstick (claim 24). Pigments are specified (column 4 lines 63-64). Parleam is disclosed (column 5 line 45).

Kantner et al teach a polyurethane dispersion useful in cosmetics such as lipsticks for forming hydrophobic films (title, column 5, lines 29-36). H12MD1 is specified (column 8 lines 15-17). Dimer diols are disclosed, including C36 difunctional polyols (column 7, lines 14, 18-20), reading on elected species D derived from saturated

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hydrocarbon-based divalent blocks from a synthetic oil or hydrogenated polyene in claims 6-8. A molecular weight of 50K is specified (column 13 line 54). Ethanol as a chain terminator is specified (column 12 lines 50-52). It would have been obvious to one of ordinary skill to use the dispersion of Kantner et al in the lipstick of Arnaud et al for the beneficial effect of forming a hydrophobic film with a lipstick. As to the product-by-process claims, the claimed process is not considered a patentable limitation during prosecution of product claims before the USPTO.

Applicants argue that because Kantner et al teach that polyurethane dispersions in hydro-alcohol systems are difficult to form, that using the polymer in Kantner et al in the composition of Arnaud et al may render the obvious combination unstable. However, as pointed out by Kantner et al in column 3 lines 11-14, their polymer is designed to be stable in hydro-alcohol systems. Applicants also argue that because Kantner et al teach stability in hydro-alcohol systems rather than the claimed continuous fatty phase, there is no reasonable expectation of success in combining Kantner et al with Arnaud et al to achieve the claimed single fatty phase system. However, it is argued that because Kantner et al teach the use of their polymer in lipsticks, one of ordinary skill would be motivated to use it in the lipstick of Arnaud et al for the benefit that the polymer affords, namely the forming of a hydrophilic film.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 571-272-0633. The examiner can normally be reached on M-F from 8 AM to 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. Kunz, can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


EDWARD J. WEBMAN
PRIMARY EXAMINER
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